

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of

Yousuke KOUNO

Group Art Unit: 2872

Application No.: 09/501,600

Examiner: A. Chang

Filed: February 10, 2000

Docket No.: 105398

For: OPTICAL FILTER AND OPTICAL DEVICE

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

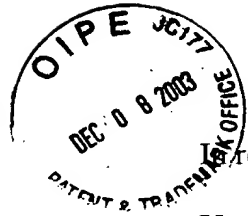
In reply to the June 9, 2003 Office Action, the shortened statutory period for reply being extended by the attached Petition for Extension of Time, Applicant requests reconsideration of this application. Claims 2, 8, 10, 12, 13 and 15-19 are pending.

As an initial matter, Applicant notes that no rejection was made against dependent claim 8.

Claims 2, 10, 12, 13 and 15-19 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,069,651 to Tsuyuki et al. in view of EP 608 169 to Albert. This rejection is respectfully traversed.

I. Independent Claims 2 and 17

The Office Action fails to address, and the applied references fail to disclose, all features of independent claims 2 and 17. Each of these claims recites that the first filter layer, which is smaller than the second filter layer, is located at a side of the optical system, and the second filter layer is located at a side of the photoelectric converter. While the Office Action



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relies upon Albert for teaching optical elements having different sizes, Albert does not disclose or suggest placing a smaller filter layer on a side of the optical system and placing the larger second filter layer on a side of a photoelectric converter. In Albert, all of the optical members 12 are held in place because they are sandwiched between the plates 8a-8d when the bolt 13 is tightened. Thus, it does not matter whether the smaller optical member 12 is located at a specific side in Albert because the optical members 12 are sandwiched by the plates.

Accordingly, Albert does not disclose or suggest all of the features recited in independent claims 2 and 17. Claims 2 and 17, along with their dependent claims, are patentable over the applied references for at least this reason.

Moreover, because the optical members 2 of Albert are sandwiched between the plates 8a-8d, as described above, the stepped portions of the overall optical device formed by the optical members 12 of Albert (which stepped portions the Office Action analogizes to the claimed "stage") are not utilized to hold the overall optical device formed by the optical members 12. Rather, the stepped portions merely function to position or guide the optical members 12 laterally with respect to each other. The overall optical device formed by the optical members 12 is actually held by being sandwiched between the plates 8a-8d.

Accordingly, Applicant respectfully submits that Albert provides no motivation to modify the structure of Tsuyuki et al. in order to achieve the combination of features recited in independent claims 2 and 17.

In addition, with respect to independent claim 17, the elements 2a-2c of Albert, which engage the external circumferences of the optical members 12 do not correspond to the claimed holding member because they do not hold the overall optical device of Albert. Rather, as discussed above, the plates 8a-8d, which do not engage the external circumferences of the optical members 12, hold the overall optical device of Albert.

Accordingly, independent claims 2 and 17, along with their dependent claims, are patentable over the applied references for this additional reason, i.e., there is no motivation to combine the references to achieve the claimed combination of features.

II. Independent Claim 13

The Office Action recognizes that neither of the applied references discloses the claimed holding member that has a spring property and that holds the optical filter by pressing the optical filter either toward a photoelectric converter or toward an optical system. As noted above, Albert sandwiches the optical elements between plates 8a-8d, and thus does not teach or suggest pressing the overall optical device of Albert in either direction.

The Office Action continues to assert that "using spring means or any other means, such as thread, for holding an optical filter in place are really art-recognized equivalent to one skilled in the art, such modification therefore is considered as obvious matters of design choice." After numerous Office Actions, the Patent Office still has not provided a reference that teaches the claim 13 holding member having a spring property. No facts are provided to support the Office Action's conclusion regarding obviousness. Thus, the Office Action relies totally on impermissible hindsight, because Applicant's specification is the only teaching of record regarding a holding member having a spring property in the combination recited in claim 13.

Because Tsuyuki et al. does not disclose filter layers that have different sizes to form a stage, Tsuyuki et al. does not disclose or suggest a holding member that holds an optical filter with a stepped portion, and does not disclose or suggest making such a holding member to have a spring property as recited in independent claim 13. Moreover, because the structure of Albert holds the optical device by sandwiching the optical members 12 between plates 8a-8d, Albert also does not disclose or suggest the claim 13 holding member that holds an optical filter with a stepped portion, or making such a holding member to have a spring property


which presses the claimed optical filter in either of the two recited directions. As noted above, Albert does not press the optical device formed by the optical members 12 in either direction.

Accordingly, Applicant respectfully submits that independent claim 13, along with its dependent claims, are patentable over the applied references.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Mario A. Costantino
Registration No. 33,565

MAC/ccs

Attachment:

Petition for Extension of Time

Date: December 8, 2003

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